

REMARKS

Claims 1 – 22 are presented for reconsideration and further examination in view of the foregoing amendments and following remarks. Claims 23-27 have been canceled.

In the outstanding Office Action, the Examiner rejected claims 1 – 11 and 13 - 22 under 35 U.S.C. §102(e) as being anticipated U.S. patent No. 6,226,618 to Downs et al.; and claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. patent No. 6,226,618 to Downs et al.

By this Amendment:

claims 3 and 4 have been amended to remove the terminology “the step(s)”;

claims 13 - 17 have been amended to place the claims in better method claim format and to remove the terminology “step”; and

claims 23 – 27 have been canceled as being drawn to a non-elected invention.

It is respectfully submitted that the above amendments and corrections do not introduce any new matter to this application within the meaning of 35 U.S.C. §132.

These amendments were not made to distinguish over any cited art. Therefore, the amendments have not narrowed the scope of the claims within the meaning defined in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722 (2002). In addition, these claims do not present any new issues that would require further consideration or search and were amended to clarify the invention.

Rejections under 35 U.S.C. 102(e)

The Examiner rejected claims 1 – 11 and 13 – 22 under 35 U.S.C. §102(e) as being anticipated by Downs et al.

Response

The rejection under 35 U.S.C. §102(e) is respectfully traversed.

For a reference to anticipate an invention, all of the elements of that invention must be presented in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

The present invention as claimed in claims 1 – 22 is directed toward an accounting printing (emphasis added) system, method and computer readable storage medium. Literary work information, which includes management information, is printed to a printing apparatus. A user information storing section 125 stores information on a user who utilizes the printing apparatus 120. An authentication processing section 127 executes authentication of the user.

On page 9, paragraph beginning on line 11 of the specification, the digital form of the literary work information is combined with the management information as accounting

information, and the accounting information is distributed to the printing apparatus. Further, as shown in Figure 1 and discussed on page 20, the paragraph beginning on line 16 of the specification, print conditions are provided only to an authenticated user.

Thus, according to the accounting printing system and method of the present invention, since the print processing of the literary (emphasis added) work information can be executed only (emphasis added) under predetermined conditions with respect to only (emphasis added) an authenticated user, it is possible to prevent the literary work information from being printed without permission and protect rights of owners of the literary work information and the printing apparatus.

Downs et al. discloses an electronic content delivery system for the distribution of digital assets such as print media, music, film, and games over a global communication network. See column 1, lines 50-57. An End-User Device 109 manages the download and storage of Secure Containers (SCs) containing Digital Content; requests and manages receipt of encrypted Digital Content keys from a Clearinghouse 105; and manages the number of copies made in accordance with the Digital Content's Usage Conditions. See column 11, lines 29-54. The SCs 200 comprise Usage Conditions 206, a Transaction ID encrypted object 205, an Application ID encrypted object 207, and encrypted symmetric key object 204, all signed with an End-User Digital Signature 202. See column 14, line 46 to column 15, line 5.

However, in each of the independent claims of the present invention, the literary work information is printed to a printing apparatus based on print conditions (such as a printing density and a printing speed) specified in the management information.

In contrast, in Downs et al., the End-User Device 109 manages the usage conditions (such as number of copies made to a CD, minidisc, or personal computer, and number of plays). The enforcement of the content Usage Conditions 517 is performed by the Content Usage Control Layer 505 in the End-User Device 109. See column 21, lines 43-63.

Further, in each of the independent claims of the present invention, information on a user is stored in a user information storing section and the user requesting print processing is authenticated by an authentication processing section.

However, any authentication processing in Downs et al. is not being performed for a user who wants the print processing of the literary work information. The Clearinghouse 105 validates and verifies all transactions that relate to the sale and/or permitted use of the Content 113 by using several complicated encryption and decryption steps that are not required by the authentication processing section of the present invention. See column 10, lines 49-67.

As such, Applicants assert that the present invention is patentable over Downs et al. as the reference does not teach or suggest each and every element of the claims.

Namely, Downs et al. does not disclose printing literary work information based on print conditions specified in management information. Instead, digital assets (such as music and games) can be copied or played based on conditions specified in the Usage Conditions.

Accordingly, reconsideration and withdrawal of the rejections is respectfully requested.

Rejections under 35 U.S.C. §103(a)

The Examiner rejected claim 12 under 35 U.S.C. §103(a) as being unpatentable over Downs et al.

Response

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) that some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) that the prior art references teach or suggest all the claim limitations. Amgen, Inc. v. Chugai Pharm. Co., 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); In re Wilson, 165 USPQ 494, 496 (C.C.P.A. 1970).

As discussed above, Downs et al. fails to disclose a printing apparatus since the digital assets are merely copied and/or played. As such, Applicants respectfully submit that the reference does not teach or suggest the features of claim 12, namely, a stencil printing apparatus, since Downs et al. is non-analogous art.

Even *assuming arguendo* that a stencil printing apparatus is “old and well-known” as asserted on page 6 of the Office Action, Applicants respectfully traverse the finding of Official Notice in this particular case since there is no technical line of reasoning that would support using a printing apparatus (specifically, a stencil printing apparatus) in the distribution system in Downs et al. Therefore, Applicants respectfully request that the Examiner cite a reference in the

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Mail Stop AF
Attorney Docket No. 24582

next Office Action that would support modifying the copy/play system in Downs et al. to incorporate the use of a stencil printing apparatus.

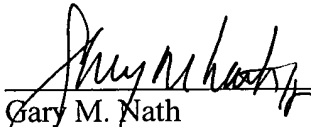
Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

CONCLUSION

In light of the foregoing, Applicants submit that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

Respectfully submitted,
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